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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91199868
Party	Plaintiff Mr. Christopher Moore
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Submission	Opposition/Response to Motion
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Date	07/09/2011
Attachments	motionlongislandroofing.pdf (8 pages)(627123 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

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MR. CHRISTOPHER MOORE,

Petitioner,

- v -

LONG ISLAND ROOFING AND REPAIRS SERVICE CORP.,

Applicant.

----------X

Opposition No. 91199868

Marks: LIROOFING.COM
LONG ISLAND ROOFING

Serial No.: 85043293
85043309

PETITIONER'S MEMORANDUM OF LAW IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Pursuant to TBMP §502.02(b) and 37 CFR §2.127(a), Petitioner Christopher Moore submits this memorandum of law in opposition to Applicant's motion to dismiss for failure to state a claim upon which relief can be granted.

Statement of Facts

The Applicant, Long Island Roofing and Repairs Service Corp., is a roofing corporation organized in the State of New York and providing services in the region of Long Island. The Petitioner owns the corporation, LI Roofing, Inc., which is also a roofing corporation organized in the State of New York and providing services in the region of Long Island. The Applicant has a website located at http://www.longislandroofing.com. The Petitioner has a website located at

http://www.liroofing.com.

The Applicant has sought to register the "Long Island Roofing" and "liroofing.com" as Trademarks. The Petitioner filed an opposition to such trademarks, leading to the instant motion to dismiss, which Petitioner hereby opposes.

Legal Argument

As stated within Page 2 of Applicant's memorandum of law, "*For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff... Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which can be proven in support of its claim.*" The only requirement is that the Petitioner give a short and plain statement that he is entitled to relief, which gives fair notice of what the claim is and the grounds upon which it rests. See Erickson v Pardus, 551 U.S. 89, 127 S. Ct. 2197 (2007).

Petitioner respectfully alleges that he has made sufficient allegations noting the nature and grounds of the claim, that if accepted as true, the Applicant's registration would be denied. Therefore, there are no grounds to dismiss the petition at this time.

One of the main grounds behind the Petitioner's claims is that the registration of "Long

Island Roofing" is merely descriptive and has not achieved any secondary meaning, therefore it cannot be registered. It is clear from the simple words themselves that "Roofing" is a generic term which cannot be registered. See Papercutter, Inc., v Fay's Drug Co., 900 F.2d 558, 14 USPQ2d 1450 (2nd Cir 1990). As alleged in the opposition, "Roofing" merely is the type of service that is provided, which most companies providing such service would have in their title. It merely describes the attributes of the service and type of business to which the word is applied , and the Applicant therefore should not be given exclusive rights to such word.

Long Island is a geographic descriptive term denoting the region in which the services are provided, as also properly alleged in the opposition. But even if not, no detailed statement of facts or other support should be required for such an argument that it apparent on its face. "Roofing" and "Long Island" are by no means unique terms or phrases. No more arguments or facts other than that should be needed to establish that Long Island Roofing is a merely a generic and descriptive term.

The two can only be registered together if the applicant has obtained a secondary meaning for the terms through usage. See Papercutter. Secondary meaning is acquired when in the minds of the public the primary significance of the term is to the source of the product and not the product itself. See Qualitex Co y Jacobson Products Co, Inc., 514 U.S. 159, 115 S. Ct. 1300 (1995). In other words, when hearing "Long Island Roofing," the general public must be aware of and immediately think of the Applicant's specific company, rather than of any general roofing company on Long Island. The burden is on the applicant to prove that there is this secondary meaning, which Petitioner asserts it cannot. Notwithstanding, this issue cannot be decided at the level of a motion to dismiss.

The second mark sought to be registered by Applicant, "liroofing.com" is not a mark used at all by the Applicant, but in fact is the Petitioner's own web address, as properly alleged in the opposition. There is no other common use of any term with a ".com" at the end of the word, except as web address. It is inherently implied that if someone holds a name with".com" at the end, or owns a registered trademark for such a mark, that one would be maintaining a web site at such .com address. Yet, such web address is that of the Petitioner, not the Applicant, and Applicant has a web site at a completely different address. Before registering a mark, the Applicant should have to have had some use of the mark. Here there is none at all, except of course the use by Petitioner. Considering that this is not the web address of the Applicant, it is confusing as to how it could ever be properly registered.

The Applicant has argued that there is also no claim because Petitioner cannot show standing. He supports this by stating that Petitioner concedes that his name of LI Roofing is not inherently distinctive. This is true that his mark is not distinctive, but neither is Applicant's. However, if Applicant obtains a trademark for "Long Island Roofing," it would have ownership over such generic and geographically descriptive words affecting not only the Petitioner, but also other similar businesses. It would effectively prohibit the Petitioner from operating his business and therefore bringing him great injury. "*In order successfully to oppose a registration, one must show that he will be injured by the registration of the mark.*" Wilson Jones Company v. Gilbert & Bennet Manufacturing Company, 332 F.2d 216, 141 USPQ 620 (2nd Cir. 1964). Because the Petitioner would be injured by not being able to run his company or business, he therefore has standing.

There is also standing to oppose the other trademark application for "liroofing.com." If

Applicant obtains a registration for liroofing.com, Petitioner's own web site, Petitioner would be prohibited from being able to use its own site. That injury is sufficient for Petitioner to have standing.

Applicant argues that the Petitioner does not have standing because he has no registered trademark, despite the fact that Petitioner would be injured by the Applicants registration. But if Petitioner's opposition is based upon the fact that Applicant's desired mark is too generic, the same would apply to Petitioner's mark, unless of course either obtained a secondary meaning.

Under Applicant's standing argument, if similar companies are operating their respective businesses with similar generic names and nobody has obtained a secondary meaning, it would be a race to the trademark office to register the generic name, with no ability of the other to oppose. Even though the law states that a generic name cannot be registered, no party would be able to raise such objection because no one has standing. Therefore, hardly anyone could ever oppose the registration of generic or merely descriptive words. This ground for opposition would be obsolete, which is an absurd result. Also, if the opposition had a registered mark, there would be no need to raise an issue of generic or descriptive words, because the defense of prior registration would be sufficient and a better argument. Therefore, the only rational argument is that one has standing if he will be injured by the registration, regardless of whether he has a registered mark or not.

Accordingly, the Petitioner has met the requirements of Rule 503.02 of the Trademark Trial and Appeal Board Manual to withstand a motion to dismiss, specifically that the Plaintiff has standing and a valid reason why the registrant is not entitled under law to maintain the registration,

which were alleged within the opposition.

The Applicant has made other arguments that Petitioner has failed to properly allege a claim for the other grounds of opposition. Petitioner respectfully asserts that each opposition claim was properly alleged by selecting the appropriate ground within the online forum for opposition, which then was supported with the factual statement attached to the opposition notice. A detailed statement of facts or other evidentiary proof is not necessary to support each and every claim, but rather Petitioner is only required that such claim is alleged. The full set of facts and proof is to be provided during discovery and inevitable hearings, but not at the pleadings stage. The facts as stated by Petitioner within the attachment to the opposition, along with such statements within the opposition, sufficiently allege claims opposing the registration, and if accepted as true, would be grounds for denying the registration.

Specifically, Applicant argues that the Petitioner completely fails to argue that the defendants marks are deceptive or deceptively misdescriptive. Petitioner has alleged that Applicant is trying to register a web address that is not owned by Applicant, but rather owned by the Petitioner. Applicant is trying to effective steal the Petitioner's site. The Applicant has never actually used the site, because it's the Petitioners. By trying to register someone else's web site claiming it as its own, the Applicant clearly has been deceptive. It would misdescribe the Applicant as the owner of, and the business behind, the company advertised at www.liroofing.com.

These same state of facts also allege a false suggestion of connection. By trying to register liroofing.com, the Applicant is falsely suggesting that there is a connection between its business and

the business behind the web site. In that the Petitioner's company is the true business behind the web site, the claim has been properly alleged. Such claims that it is Applicant's web site also constitutes fraud. Applicant has no association whatsoever with liroofing.com, and must be prevented from alleging that it has.

Conclusion

For the foregoing reasons, the Petitioner s respectfully requests that the Board deny the Applicant's motion to Dismiss, and for such further relief as is just and proper.

Dated: July 8, 2011

Christopher Moore
PETITIONER
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CERTIFICATE OF MAILING AND SERVICE

I certify that on July 11, 2011, the foregoing **PETITIONER'S MEMORANDUM OF LAW IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS** is being served by email and mailing a copy thereof by FedEx addressed to:

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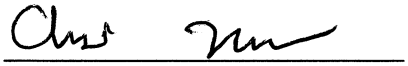
By: 

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